

09/848,003  
Art Unit 3693  
9227.00

#### **REMARKS**

This Amendment is submitted in response to the Office Action mailed on April 19, 2007. Claims 1 - 6 and 22 - 31 are pending, and all stand rejected at present.

#### **RESPONSE TO ASSERTION OF CONSTRUCTIVE ELECTION**

The Office Action, pages 2 and 3, asserts that Applicant has constructively elected to prosecute claims 1 - 6, to the exclusion of added claims 22 - 31.

However, several problems exist in this assertion by the PTO.

#### **Problem 1**

The assertion is contrary to general legal principles.

In the legal system, a "constructive" election is assumed to be made, based on the conduct of the party, when the party fails to make an express election.

That is, if a party behaves as though an election were made, the conclusion may be proper that the party intended to make the election, but forgot to do so.

This concept simply does not apply here, because the facts do not support, and are not consistent with, any intent by Applicant to withdraw the claims in question.

Applicant asks: Why did Applicant undertake the effort to (1) write the added claims and (2) distinguish them over the prior art,

09/848,003  
Art Unit 3693  
9227.00

as done in the previous Amendment, if Applicant intended to ignore the claims ?

From another perspective, the PTO is asserting that Applicant deliberately undertook actions which were pointless. The PTO is asserting that Applicant undertook a premeditated waste of time.

The PTO's assertion is contrary to the facts, and contrary to common sense.

As a minimum, the PTO must explain what purpose was served by Applicant's drafting of claims 22 - 31, if Applicant intended them to be withdrawn immediately upon submission.

That is, the PTO must show some clear purpose in Applicant's submission of the claims, other than for the purpose of having them examined.

## **Problem 2**

The Office Action cites 37 CFR § 1.142(b) and MPEP § 821.03 in support of its position. However, neither of those references supports the PTO's position.

The CFR section merely states that, if an election is made, the non-elected claims are automatically withdrawn.

The MPEP section merely states that, if restrictable claims are added after an office action, then the PTO may issue a restriction requirement.

But neither section discusses a "constructive" election.

09/848,003  
Art Unit 3693  
9227.00

Applicant points out that the PTO has not followed the MPEP section which it cited. That section mandates issuance of a restriction requirement, when a second invention appears in added claims.

No restriction requirement has been issued.

### **Problem 3**

The PTO's assertion is without logical foundation. Why were claims 1 - 6 constructively elected, rather than claims 22 - 31 ?

That is, what is the evidentiary basis for the PTO's withdrawing claims 22 - 31, rather than claims 1 - 6 ?

### **Problem 4**

The PTO's basis for the "election" is that claims 22 - 31 represent a different invention. However, the Office Action applies an incorrect test as to whether a second invention is added by the new claims.

The Office Action states that claims 22 - 31 cover an invention which is "independent **OR** distinct" from that of claims 1 - 6. (Office Action, page 2, section 5.)

That is not the legal test. The test is whether the two elements are "independent **AND** distinct." (35 USC § 121; MPEP § 802.)

Therefore, even if the PTO's arguments are correct (which is

09/848,003  
Art Unit 3693  
9227.00

not so), they are based on an incorrect rule. The PTO applied the wrong rule.

#### Problem 5

MPEP § 802.01 defines "independent" and "distinct." The Office Action has not applied those definitions, but has merely asserted that claims 1 - 6 cover **something different**, compared with claims 22 - 31.

The mere fact that the two groups of claims are **different** does not mean that they are "independent and distinct."

Further, it is **required** that different claims cover different subject matter. Thus, the added claims **must be different**. If they are not, they can be rejected as duplicative.

#### Problem 6

MPEP § 802.01 states that "independent" means that the two inventions are "unconnected in design, operation **AND** effect."

Applicant points out that both inventions in question have the same effects, namely, executing a transaction at a self-service terminal for a customer. Both have the same type of operation, namely, executing a transaction with a customer, through a portable device.

#### Problem 7

09/848,003  
Art Unit 3693  
9227.00

MPEP § 802.01(II) states that, if the inventions are not "independent," then, for the two inventions to be "distinct," one must be patentable over the other.

The PTO has not shown that the two inventions are patentable over each other.

### **Problem 8**

The PTO's position creates a Catch-22.

MPEP § 714 et seq. and 37 CFR § 1.121 state that an Applicant may amend the claims, in response to an Office Action.

But the present Office Action asserts that, if claims are added, which are different from pending claims, then the added claims can be peremptorily withdrawn by the Examiner, without Applicant's choice or consent.

So here is the Catch-22:

- The rules say that claims can be added.
- Other rules say that different claims must be different.
- But the Office Action states that, if different claims are added, the PTO can peremptorily withdraw them.

Thus, it is impossible to amend an application, under the PTO's view.

09/848,003  
Art Unit 3693  
9227.00

#### **Additional Point 1**

The undersigned attorney drafted added claims 22 - 31. At no time did he have an intent to constructively elect to withdraw those claims.

#### **Additional Point 2**

The previous Amendment has been entered. The undersigned attorney is aware of no authority which allows the PTO to arbitrarily withdraw selected claims presented in an Amendment. It is requested that the PTO identify such authority.

### **RESPONSE TO OBJECTION TO DRAWINGS**

#### **Point 1**

Objection was registered to the absence of call-out "54" from Figure 4. (Office Action, page 3, section 6, line 3.)

However, element 54 is a loudspeaker, and is shown in Figure 3. Applicant fails to see why it must also be shown in Figure 4.

Further, Figure 4 is an **external view** of the cell phone. The loudspeaker 54 would not be visible in such a view, because the loudspeaker 54 is **inside** the cell phone.

Applicant's previous amendment corrected any error in the Specification, which error may have referred to an (absent) loudspeaker 54 in Figure 4. That amendment is repeated here, in part:

09/848,003  
Art Unit 3693  
9227.00

Fig 4 is a schematic view of the cellphone 24, which has a body 80 housing the loudspeaker 54 (shown in Fig 3) . . .

Therefore, Applicant sees no reason to add a call-out "54" to Figure 4, because (1) no loudspeaker 54 is shown in Figure 4 (it is shown in Figure 3), and (2) the Specification does not state that a loudspeaker 54 is present in Figure 4.

#### **Point 2**

Objection was registered to the absence of call-out "40" and "60" from Figure 8. (Office Action, page 3, section 6, lines 3 and 4.)

As to the latter call-out "60," Applicant points out that the Specification, page 11, line 16, states that "IR port 60" is shown in Figure 3, not Figure 8.

As to the former call-out "40," Applicant points out that the "user interface 40" is discussed on page 11, lines 15, 16. The amendment to the Specification, given above, changes that passage to state that the "user interface 40" is shown in Figure 2.

Therefore, Applicant fails to see any problem with the drawings in this respect. The Specification explains where, in the drawings, the two elements "40" and "60" are located.

#### **Point 3**

09/848,003  
Art Unit 3693  
9227.00

The Office Action, page 3, bottom, asserts that, with respect to Figure 8, "reference character 42 has been used to designate both 'IrDAport' and 'communications port'."

However, Applicant points out that Figure 8 does not contain the terms "IrDAport" nor "communications port." Therefore, the assertion of the Office Action is incorrect.

The Office Action seems to object to the fact that the Specification gives two names to a single element, namely, element 42. But there is no problem in this dual nomenclature, particularly since the two names have a genus-species, generic-specific, or set-subset relationship.

That is, element 42 is called a "communications port" (the generic term), which may take the form of an "IrDAport" (the specific term.)

This has been made clear in the amendment to page 112, lines 15, 16, made in Applicant's previous response, which is repeated here:

To execute this transaction, the user 110 approaches ATM 14 and aligns the IR port 60 (Fig 3), which may take the form of an IR port, with the communications port 42, also called an IRDA port, in the user interface 40 of the ATM 14.

Applicant points out that these two terms are required by the rules of the Patent Office. The Specification is required to

09/848,003  
Art Unit 3693  
9227.00

provide support for terminology which may be used in the claims. Broad claims may use the term "communications port." Narrower claims may use the term "IRdAport."

#### **Point 4**

The Office Action, page 4, top, asserts that, with respect to Figure 8, "reference character 60 has been used to designate both 'IR port' and 'port'."

However, Applicant points out that Figure 8 does not contain the terms "IR port" nor "port." Therefore, the assertion of the Office Action is incorrect.

The Office Action appears to object to the fact that the Specification gives two names to a single element, namely, element 42. But there is no problem in this dual nomenclature, particularly since the two names have a genus-species, generic-specific, or set-subset relationship.

#### **Comment on Drawing Objections**

Applicant is perfectly willing to comply with the PTO's requests that accurate drawings be submitted.

Consequently, Applicant respectfully requests that the PTO explicitly state what corrections are requested to be made to the drawings.

The PTO has not done this. Instead, the PTO has only demanded

09/848,003  
Art Unit 3693  
9227.00

that certain supposed errors be corrected. However, as explained above, those "errors" do not actually exist. Further, also as explained above, no lack of clarity exists in the Specification-drawings combination. Consequently, Applicant has no idea (1) what the PTO is looking for nor (2) how to correct the drawings.

Again, Applicant requests that the PTO explicitly state what it wants in the drawings.

## RESPONSE TO CLAIM OBJECTIONS

### Response 1

The Office Action, pages 5 and 6, asserts that the "wherein" clause of claim 1 recites an "optional" element/step, which is not limiting. The Office Action cites MPEP § 2114.04 in support.

### Point 1

Applicant points out that this MPEP section merely states that certain language **SOMETIMES** can be non-limiting. This MPEP section does not give a specific example for a "wherein" clause, but does give two examples for "whereby" clauses.

-- In one example, the whereby clause **was** found limiting.

-- In the other example, the whereby clause was found **non-limiting** (because the clause stated an intended result).

09/848,003  
Art Unit 3693  
9227.00

Therefore, this MPEP section clearly states that a "wherein" clause (or the like) is **not necessarily** non-limiting: such a clause can be a limitation, as the first example illustrates.

Consequently, the PTO must provide reasons explaining why the "wherein" clause in claim 1 is non-limiting. Reasons are required because, as just explained, this type of clause is **NOT PER SE defective**.

The MPEP expressly states that this type of clause **CAN BE LIMITING**.

#### Point 2

The word "wherein" means "in which." "Which" refers to the claimed elements recited in the claim.

Thus, the "wherein" clause sets forth characteristics which are found "in" the claimed elements. Those characteristics are that

the user's portable device makes the authorization request of a remote party, and transmits authorization received in response to the authorization request to the communication port.

This clause is clearly not a statement of intended purpose. This clause sets forth characteristics of the recited elements, and thereby sets forth definitions of those elements.

09/848,003  
Art Unit 3693  
9227.00

## **Response 2**

The Office Action, page 6, objects to the term "device," and gives it no patentable weight.

In response, Applicant points out that every claim is read **as-a-whole**. A claim is not a collection of individual words, each having no patentable weight. All the words act together (as-a-whole), to provide overall meaning.

Claim 1 states that the "device" is "portable" and "electronic." Those characteristics, by themselves, indicate that a mere "device" is not being claimed. A "portable" "electronic" "device" is being claimed.

Further, the claim states that the "device" (1) "makes the authorization request of the remote party" and (2) "transmits authorization received in response to the authorization request to the communication port."

These recitations defeat the PTO's assertion that "the 'device' could be any device . . ."

A specific device, having specific characteristics, has been recited.

The claim does not merely recite a "device."

## **RESPONSE TO 103 - REJECTIONS**

Claims 1 - 6 were rejected as obvious, based on Kawan and Grunbok.

09/848,003  
Art Unit 3693  
9227.00

**Point 1**

**Even if References are Combined,  
Claimed Invention is not Attained**

The Office Action cites Grunbok, column 3, line 66 - column 4, line 35, as showing the claim recitations that

1) the portable device (eg, a PDA) obtains authorization, as from a bank in which a credit card account exists

and

2) the portable device transmits the authorization to the SST, via the "port."

(The SST would then levy a charge against the credit card, based on the authorization.)

However, Grunbok does not actually show that.

In the cited passage of Grunbok, the PDA contacts one or more banks 30, 32, 34 etc. in his Figure 1. (Grunbok calls those entities 30, 32, 34 etc. "Financial Institution Computer Systems," that is, computers of banks. For simplicity, they will be called "banks" herein.)

After contacting the banks, the PDA in Grunbok transfers money

1) **from** one or more accounts in the banks,  
which are controlled by the PDA

09/848,003  
Art Unit 3693  
9227.00

2) to one or more accounts in the banks,  
which belong to the "store."

That does not show the claim recitation in question. In Grunbok, there is no delivery of "authorization" as claimed to an SST. The "authorization" is plainly authorization to charge an account. But that is not necessary in Grunbok because, as just explained, the PDA alone transfers money from one account to another.

Therefore, the claimed "[transmitting of] authorization received in response to the authorization request to the communication port" of the SST is not found in the cited passage in Grunbok. Even if the references are combined, this recitation is not found.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

## **Point 2**

### **Grunbok Shows Multiple Embodiments**

#### **Most are Contrary to Claim 1**

#### **No Teaching Given for Ignoring Those Embodiments**

In the context surrounding the passage cited by the PTO, Grunbok states that **either** the PDA, or the computer system 20 in

09/848,003  
Art Unit 3693  
9227.00

his Figure 1, can handle the funds transfer. (Column 4, line 66 - column 5, line 4.)

If the computer system 20 handles the funds transfer, then the PDA is not involved. To understand this, assume arguendo that the funds transfer in Grunbok involves the steps recited in claim 1 (even though this was disproved in the preceding Point 1, above). If Grunbok's computer system 20 handles the transfer, then the claimed operation of the PDA is not found.

The PTO has provided no teaching for selecting one type of operation in Grunbok, over another, for combination with the Kawan reference. A teaching is required.

From another perspective, you could just as well combine the elements of Grunbok discussed immediately above. If you do, you do not obtain the claimed invention.

No teaching has been given for making one combination, as opposed to another.

### Point 3

This is a continuation of Point 2.

Grunbok discusses several other modes of operation, which also do not involve the PDA as recited in claim 1. These are outlined in his Summary of the Invention, wherein he discusses five "general aspects."

In the "first general aspect" (column 1, lines 35 - 60),

09/848,003  
Art Unit 3693  
9227.00

Grunbok appears to state that the PDA can access a sufficient number of credit card accounts, or other accounts, to obtain payment for the store. He discusses payment to the store, but does not state precisely how the payment is made.

In the "second general aspect" (column 1, line 61 - column 2, line 7), Grunbok states that the PDA communicates with a store computer, which then communicates with a financial computer. This clearly does not show claim 1.

In the "third general aspect" (column 2, lines 8 - 20), Grunbok states that the PDA causes a bank computer, where the PDA owner has an account, to transfer funds to an account of the store. This clearly does not show claim 1.

In the "fourth general aspect" (column 2, lines 21 - 33), Grunbok gives a very fuzzy description which is difficult to understand, but does not appear to be even close to claim 1. One reason is that he refers to a "means for communicating with a financial institution of the store" and also with "a financial institution of the hand held computer user." That "means" is not the PDA, because Grunbok in this "aspect" refers to the PDA as the "hand held computer." Thus, this "aspect" also does not show claim 1.

In the "fifth general aspect" (column 2, lines 34 - 46), Grunbok appears to be creating textual support for a specific type of claim, namely, a computer-program-stored-in-tangible-medium.

09/848,003  
Art Unit 3693  
9227.00

He states here that the PDA transfers money from one institution to another. But he does not discuss a self-service terminal. Again, this "aspect" does not show claim 1.

Therefore, Grunbok discusses at least four alternate modes of operation (or "aspects"), which do not show the required recitations of claim 1.

Consequently, a teaching is required for ignoring those embodiments of Grunbok, and for selecting that embodiment chosen by the PTO over those embodiments.

No teaching has been given.

#### **Point 4 - Contradictory References are Being Combined**

The Kawan reference states that a person can insert a smart card into a PDA. The smart card apparently contains identifying information about the person. The PDA can demand such information from the person, such as a PIN or fingerprint, and thereby identify the person.

Although it is unclear, Kawan may be stating that, once this identification is made, the PDA can instruct an ATM to dispense cash, based on the smart card.

However, no contact by the PDA or smart card of any remote terminal is seen in Kawan. Thus, there is no "authorization request" made of a "remote party," as claimed.

Grunbok is cited to show this "authorization request."

09/848,003  
Art Unit 3693  
9227.00

However, if this "request" is present in Grunbok, that is contrary to Kawan. The reason is that, as just explained, Kawan's PDA/smart-card combination makes no "authorization request" as claimed.

The references are contradictory. According to the PTO's admission, one makes the "request," and the other does not.

**Point 5 - No Expectation of Success Shown**

No expectation of success has been shown, indicating that the combination of references actually works.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must . . . be found in the prior art and not based on applicant's disclosure.

The Office Action has not explained exactly what is obtained by combining the references. Thus, no device which operates successfully has been demonstrated.

09/848,003  
Art Unit 3693  
9227.00

For example, even assuming that Grunbok shows the recitations attributed to him (that is, a PDA's obtaining of authorization from a remote party and then transferring that authorization to a self-service terminal), the PTO has not explained how that is actually combined with Kawan.

What does Kawan do with that authorization ? Kawan already knows how to dispense cash, using the PDA/smart card combination. What purpose does the "authorization" serve ?

Further, adding the "authorization" to Kawan defeats Kawan's purpose. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE  
PRIOR ART UNSATISFACTORY FOR ITS INTENDED  
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE  
PRINCIPLE OF OPERATION OF A REFERENCE.

That is, Kawan, by himself, seems to state that the PDA/smart-card combination, by itself, is sufficient to cause the ATM to dispense cash.

If the "authorization" is then also required, what happens if the "authorization" fails ? For example, suppose a thunderstorm knocks out communication with the computer which is supposed to grant "authorization." Kawan is rendered inoperative.

#### **Point 6 - No Teaching Given**

09/848,003  
Art Unit 3693  
9227.00

The rationale for combining the references is that adding the teachings of Grunbok

. . . would allow Kawan to have a faster and more efficient means to transmit an authorization request to a self-service terminal communication port.

However, several problems exist in this rationale.

#### Problem 1

The rationale must be shown in the prior art. That has not been done. MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

. . . .

The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art and not based on applicant's disclosure.

#### Problem 2

The rationale is purely conclusory, in asserting that

09/848,003  
Art Unit 3693  
9227.00

"efficiency" and speed are increased. But no evidence in support of the conclusions has been given. Evidence is required.

Without evidence, the rationale is nothing more than empty words.

#### Problem 3

The rationale has not shown why Kawan would even need an "authorization request." Thus, it makes no difference whether adding Grunbok makes transfer of the request "faster" or "more efficient."

Stated bluntly, the rationale is irrelevant.

#### Problem 4

It is impossible to verify whether the rationale is correct or not. Thus, the rationale must be meaningless.

That is, Kawan, as cited, does not use an "authorization request." Consequently, one cannot say that addition of such a "request," when none existed before, makes that (non-existent) "request" "faster" or "more efficient."

If the "request" is not present in Kawan initially, then there is no basis of comparison.

By analogy, if you put a love seat into the back of a pick-up truck, where no love seat previously existed, you cannot say "The love seat in the back of my truck is now more comfortable."

09/848,003  
Art Unit 3693  
9227.00

That is a meaningless statement, because there was no previous love seat by which to make a comparison.

A similar principle applies to the non-existent "request" in Kawan.

#### **Remaining Claims**

The discussion above applies to the remaining claims.

Claims 22 - 31 have not been rejected, and therefore should be allowed.


Applicant points out that claim 22(a) is not found in either reference.

#### **CONCLUSION**

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,

  
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09/848,003  
Art Unit 3693  
9227.00

Please replace the Abstract with the following. (A clean copy follows.)

#### ABSTRACT

A self-service terminal ~~(14)~~, such as an ATM (Automated Teller Machine), ~~and a portable electronic device (24), such as a cellular telephone or a PDA, are described.~~ The ATM has a communication port ~~(42)~~ for interfacing with a user's portable electronic device ~~(24)~~; ~~a dispenser (32) for dispensing valuable items; and an authorization approval facility for approving a transaction authorization.~~ The ~~terminal (14)~~ ATM is operable to receive a transaction authorization from ~~a user's device (24)~~ the user's portable electronic device, to examine the transaction authorization, and to dispense an item to fulfil a requested transaction associated with the transaction authorization, without the terminal preparing an authorization request to a remote computer.